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JUL 19 2011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
Jeffery Enright)	
)	
Application No.: 09/991,748)	Art Unit 3691
)	
Confirmation No.: 7030)	
)	
Filed: November 23, 2001)	Patent Examiner
)	Frantzy Poinvil
)	
Title: Automated Banking Machine)	
System and Method)	

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REQUEST FOR EXPRESS ABANDONMENT OF APPLICATION

This application is hereby expressly abandoned (37 CFR 1.138).

The abandonment of this application does not constitute an admission that the Examiner's position is correct. Rather, Applicant continues to respectfully disagree with the rejections. The Applicant contends that the claims are patentable. The Examiner's pattern of unreasonableness is the major reason for the abandonment. Additional remarks follow.

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**THE PROSECUTION HISTORY SHOWS THE EXAMINER
TO BE UNREASONABLE WITH REGARD TO MANY ISSUES**

Examples of the Examiner's unreasonableness follow.

Unnecessary Office-Caused Prolonged Prosecution

The Applicant respectfully declines to participate in further unnecessary prosecution.

This application, which was filed November 23, 2001, has been pending almost ten (10) years.

As the prosecution record shows, the Office failed in its prosecution duty, especially with regard to "compact prosecution".

According to MPEP § 708.01 (listed reason "T") and § 707.02, an application pending more than *five* years was to have been treated as a "special" case and be advanced out of turn by the Office. That is, this application was to have been given a very high priority by the Office in the order of examination (MPEP § 708), and its priority handling was to have been personally overseen by the supervisory patent Examiner (SPE) (MPEP § 707.02). The application was to have been given high priority in an Examiner's docket so it could be treated by the Office in a quicker manner. Unfortunately, the record shows that this application was never treated as "special" by either the Examiner or the Office.

One skilled in the art of patent prosecution would recognize that this application should have been allowed long ago. The Applicant respectfully disagrees with the unreasonable positions taken by the Examiner. The Examiner still has not identified a *valid* reason for the holding of obviousness, in violation of *KSR International Co. v. Teleflex Inc.*, U.S., No. 04-1350, April 30, 2007. The current status of the application points to continued harmful prolonged prosecution.

The Office-caused prolonged prosecution appears to be nothing more than an effort by the Office to improperly deny Applicant a grant of patent. Such agency action constitutes an abuse of agency authority and violates the Administrative Procedures Act, 5 U.S.C. § 701 *et seq.*

Errors In The Office Action Dated March 2, 2011

In accordance with 37 CFR § 1.111(b), the Applicant has a duty to point out clear "errors in the examiner's action" (MPEP § 714.02). The Applicant disagrees with this duty because supervision should be provided by the Office itself. Nevertheless, examples of clear errors by the Examiner follow. As seen, these errors merely follow a prosecution pattern of errors.

Error #1

Claims 1-41 were pending (at the time of the March 2, 2011 Action), as evidenced by the amendment of November 22, 2010. Yet only claims 1-39 were examined. More prosecution will be required to fix this error. Thus, the Examiner continues to unnecessarily prolong prosecution.

Error #2

Claim 30 was rejected under 35 U.S.C. § 102(e) as being anticipated by Stinson (US 6,149,056). Yet this *identical* rejection was already fully considered by the BPAI in Appeal No. 2008-004397. The BPAI reversed the Examiner's rejection of claim 30. For example, note the BPAI decision dated November 2, 2010 at pages 22-23 and 25, with regard to claim 30.

The Examiner was legally barred (based on principles of *res judicata*) from again asserting this same rejection. Prosecution cannot be based on double jeopardy. The Examiner has no authority to reintroduce a rejection which was already reversed by the BPAI. Clearly the rejection of claim 30 is legally improper. Such rejection also appears to be unethical. The Examiner has committed prejudicial error. As can be seen, the Examiner continues to unnecessarily prolong the prosecution, which has a length that is arbitrary and capricious, if not endless.

Error #3

Claims 36-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stinson in view of Norris (US 5,940,811). That is, the Examiner now additionally relies upon Norris to reject claims 36-38. It follows that the Examiner has admitted (by inference) that claims 36-38 cannot (as previously alleged by the Examiner) be anticipated by Stinson alone. Why then did the Examiner require Applicant to appeal the prior 35 U.S.C. § 102(e) rejection of claims 36-38 based on Stinson alone? The Examiner's current admission is an admission of clear error. If the Examiner is treating the prosecution as a game, then it is against Applicant's ethics to play.

Error #4

Claim 34 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Stinson in view of Norris. However, the Examiner never addresses claim 34 in the Action. The Applicant has a right to view the reasoning and evidence on which the claim 34 rejection is based. Otherwise, the rejection (being absent any valid reasoning) is not a legally valid rejection. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). It follows that a *prima facie* case of obviousness has not been established.

Error #5

A 37 C.F.R. § 1.132 declaration was filed November 22, 2010. The declaration established that Stinson does not provide any teaching to the person of ordinary skill in the art at the time of the present invention to have produced the claimed invention. Unfortunately, instead of the declaration being provided its appropriate evidentiary weight, there is no evidence of record that the Examiner ever considered the declaration. This inaction is further unreasonable.

Also, how can Stinson anticipate the claims when Stinson does not even teach, mention, or need “electronic signature”? It follows that the Stinson-based anticipation rejections, in view of the person of ordinary skill in the art of patent prosecution, appear to be nothing more than a legally improper attempt to collusively apply an “obviousness” rejection through the back door.

Error #6

The Action at page 2 (paragraph number 1) states that “Applicant’s submission filed on 08/30/2010 has been entered”. However, there is no evidence in the record of any filing by Applicant on August 30, 2010. Apparently the Examiner has confused Applicant’s application with another application, which is further inconceivable.

Error #7

The Examiner misconstrues the Norris reference. Norris does not teach or suggest “electronic signature”. Nowhere does Norris teach or suggest having an automated banking machine receive a user-inputted agreement from a machine user to use that user’s image as that user’s legally binding electronic signature for purposes of signing a document. Rather, a person’s signature in Norris is obtained by having the person use an electronic pen (105) to provide a hand written signature on a signature pad (100) (col. 9, lines 19-20 and 47-49). The signature pad (100) conventionally converts motion of the electronic pen (105) to an electronic image. The Examiner confuses an electronic image of an electronic pen’s motion with an image of a machine user. One skilled in the art of automated banking machines would not have this confusion, especially when it is the automated banking machine’s camera that operates to capture the image of the machine user. As can be seen, the Norris-relied upon rejections further exemplify the Examiner’s unreasonableness.

**The Prosecution History Suggests The Examiner
Will Continue To Be Unreasonable**


The record indicates a pattern of obfuscation and delay by the Office with regard to the instant application. Regardless, Applicant respectfully declines to continue participation in a prosecution which points to a pattern of Examiner unreasonableness, especially when it is directly contrary to the legal facts of record. The unreasonableness, which unfortunately has become predictable, indicates to the Applicant that no amendment (nor BPAI reversal) would appease the Examiner to soon allow the application. Again, the Applicant respectfully declines any invitation to participate in even more acts of Examiner unreasonableness, even though the Examiner's positions with regard to the rejections are legally improper.

**Applicant Reserves All Rights To Refile
The Recited Subject Matter**

The Applicant does not waive any right to obtain similar claim coverage through a different U.S. application. That is, the Applicant reserves all rights to have similar subject matter considered by another Examiner, including a (reasonable) Primary Examiner in a different Art Unit or Technology Center.

Respectfully submitted,

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